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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,487	07/23/2003	Shih-Fan Wang	Q76671	7818
23373	7590	12/23/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			CHU, JOHN S Y	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/624,487	WANG ET AL. <i>A</i>	
	Examiner	Art Unit	
	John S. Chu	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/6/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed July 23, 2003.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

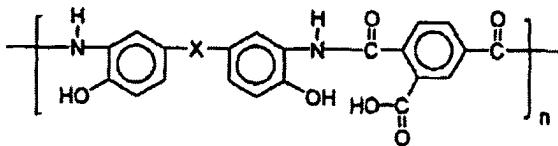
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11, 13-28, and 30-33 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by TOMIKAWA et al '764.

The claimed invention is drawn to the following:

1. A positive photosensitive composition, comprising:
a poly(imide-benzoxazole) precursor prepared by the
reaction of trimellitic anhydride halide monomer
with bis(o-diaminophenol) monomer, wherein the
poly(imide-benzoxazole) comprises at least a
repeating unit as the structure below:



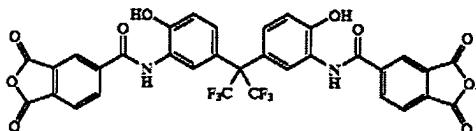
wherein the X is -O-, -S-, -C(CF₃)₂-, -C(CH₃)₂-, -CO-, -CH₂-, -NHCO-, -SO₂-, -SO-, or a bond;
and

n is an integer from 10 to 100;

a photosensitizer; and

a solvent.

TOMIKAWA et al discloses a positive photoresist composition comprising a polyimide precursor and a naphthoquinonediazide compound. The claimed poly(imide-benzoxazole) precursor is anticipated at Examples 1 and 2 found in column 26, line 45 – column 27, line 51. These examples disclose a polybenzoxazole precursor made from a diamine and an acid anhydride of Synthesis Example 5. Synthesis Example 5 as disclosed in column 18, lines 35-61 disclose the following acid anhydride structure:



which is made by reacting a trimellitic acid anhydride chloride with a diamine of 2,2 bis(3-amino-4-hydroxyphenyl) hexafluoropropane. The resulting structure is then reacted with another diamine as recited in Example 1 forming a poly(imide-benzoxazole) precursor which is then added to a naphthoquinonediazide compound. TOMIKAWA et al characterize the resulting composition as Varnish A. Varnish A as recited anticipates the claimed positive photosensitive of the current application.

Likewise Example 2 discloses a reaction between a diamine compound and the acid anhydride of Synthesis Example 5. This reaction yields a poly(imide-benzoxazole) precursor which is then mixed with a naphthoquinonediazide compound, giving a Varnish B (column 27, lines 33-41). Varnish B as recited anticipates the claimed positive photosensitive of the current application.

Subsequently each of Example 1 and 2 are processed by coating on a silicon wafer, exposed through a photomask, developed and dried. The disclosed Examples meet the claimed method as recited in claim 18-28 and 30-33.

The arguments by applicant have been carefully considered, however are unpersuasive for the following reasons:

1) Applicants have misinterpreted the Office action and the prior art reference of TOMIKAWA et al. The 102(e) rejection refers to Examples 1 and 2 as anticipating the claimed invention as recited on page 3, line 3 of the Office action. These two examples disclose a composition comprising a poly(imide-benzoxazole) which is made from an trimellitic anhydride chloride of Synthesis Example 5 and a diamine of 2,2 bis(3-amino-4-hydroxyphenyl) hexafluoropropane. This polymer meets the defined “n” value of claim 1, see column 2, lines 15-19 wherein n=10 – 100,000.

The rejection given in the Office action mailed July 7, 2004 is repeated.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

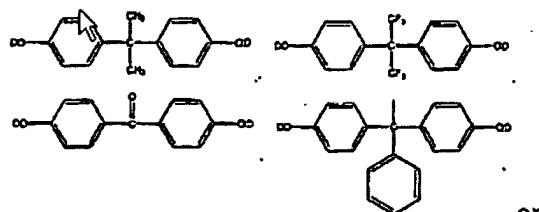
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over TOMIKAWA et al.

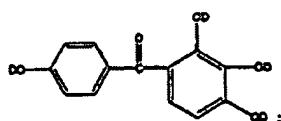
The claimed invention has been recited above and is included by reference. Claims 12 and 29 previous omitted in the previous rejection recited the following:

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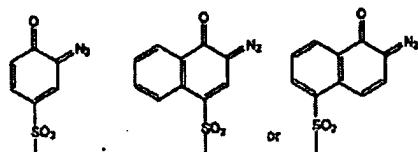
12. The positive photosensitive composition as claimed in claim 1, wherein the photosensitizer comprises diazonaphthoquinones as the structures of



or



wherein D is hydrogen,



TOMIKAWA et al has been recited above for the disclosures in Examples 1 and 2, which anticipate claims 1-11 and 13-28, and 30-33. These examples fail to explicitly recite the particular quinonediazide compound mixed with the claimed poly(imide-benzoxazole) precursor of claim 1. However Synthesis Examples 4, 18 and 20 found in column 18, lines 10-34, column 25, lines 16-54, and column 26, lines 16-44, respectively disclose quinonediazide (NQD) compounds which meet the claimed NQD compounds recited in claims 12 and 29.

TOMIKAWA et al discloses the suitable use of several NQDs as long as the phenol compound condensed with the naphthoquinonediazidesulfonyl chloride has a dipole moment of 0.1 to 1.6. Here the skilled artisan is taught to use any of the phenol compound to make the photosensitive NQD compound with the stipulation of having the disclosed dipole moment.

It would have been *prima facie* obvious to one of ordinary skill in the art of positive photoresist composition comprising an NQD to select anyone of Synthesis Examples 4 18 or 20 in place of Synthesis Example 1 and 2 in Examples 1 and 2 as a photosensitizer with the reasonable expectation of same or similar results with respect having low film loss in the unexposed regions.

For the reasons above, the current rejection is repeated wherein a *prima facie* case of obviousness is made over TOMIKAWA et al.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

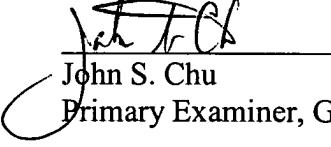
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for the USPTO is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John S. Chu

Primary Examiner, Group 1700

J.Chu

December 20, 2004